

REMARKS

I. STATUS OF THE APPLICATION

Claims 1-33 were originally filed in the present case. Claims 34-44 were added in a Preliminary Amendment mailed May 14, 2004. In an Amendment accompanying the Response to Office Action mailed May 17, 2005, the Applicants have cancelled claims 1-44, and added claims 45-83. Therefore, claims 45-83 are currently pending.

In a section entitled “DETAILED ACTION” of the Office Action of May 4, 2006 the Examiner states:

“Claims 48, 49, 55-72 and 81-83 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable or generic linking claim. Election was made **without** traverse in the reply filed on 6/21/05 and 2/17/06.” (Office Action of May 4, 2006, page 2). (Emphasis in original.)

This is a reiteration of the Examiner’s earlier assertion:

“Claims 55-72 and 83 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions (sic), there being no allowable generic or linking claim.” (Office Action of September 22, 2005, page 2.)

Again, the Applicants note that the Examiner cannot withdraw claims at present. To the contrary, and as pointed out to the Examiner in the Amendment and Response to Office Action of September 22, 2005, claims 48, 49, 55-72 and 81-83 are drawn to the subject matter of the Examiner’s Group I, a ballistics calculator system, elected by the Applicant in accord with the Examiner’s requirement for restriction. (Office Action of May 17, 2005, page 2.) While the subject matter of claims 48, 49, 55-72 and 81-83 may

relate to non-elected species, a species election does not result in withdrawal of the claims. Instead, if the generic claim is found allowable, the unelected species claims are examined. In the Office Action of May 4, 2006 the Examiner has apparently confused the Applicant's response to the Examiner's requirement for restriction (*i.e.*, the claims of Examiner's Group I), with the Applicant's response to the Examiner's request for species elections (*i.e.*, the target application device, and type of reticle being used, of Claim 45). For these reason, the Applicants respectfully request that the Examiner's impermissible withdrawal be withdrawn.

II. REJECTIONS

For clarity, the rejections are set forth in the order that they are herein addressed.

A. 35 U.S.C. §112

In the Office Action of May 4, 2006 the Examiner has rejected claims 45-47, 50-54, and 73-80 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The Examiner notes: "Claim 45 recites the limitation "said primary vertical cross-hair" in line 9. There is insufficient antecedent basis for this limitation in the claim." (Office Action of May 4, 2006, page 2). Accordingly, in the present Amendment and Response to Office Action of May 4, 2006, claim 45 is amended to read: "a visible primary vertical cross-hair."

The Examiner notes: "Claim 74 recites the limitation "said primary horizontal cross-hair". There is insufficient antecedent basis for this limitation in the claim." (Office Action of May 4, 2006, page 2). The Applicants respectfully disagree. Claim 74 recites "a primary horizontal cross-hair" at line 3 of the claim thereby providing the antecedent basis for "said primary horizontal cross-hair" at line 6 of claim 74.

The Examiner notes: "Claim 77 recites the limitation "the opposite end". There is insufficient antecedent basis for this limitation." And: "The term "the opposite end" in

claim 77 is a relative term which renders the claim indefinite. The term “the opposite end” is a spatially relative term that is not defined by the claim, and one of ordinary skill in the art would be reasonably apprised of the scope of the invention.” (Office Action of May 4, 2006, pages 2-3). The Applicants respectfully disagree. However, in order to expedite the patent application process in a manner consistent with the U.S. Patent and Trademark Office’s Patent Business Goals (PBG)¹, and without waiving the right to prosecute the amended or cancelled claims (or similar claims) in the future, in the present Amendment and Response to Office Action of May 4, 2006, claim 77 is amended to read: “an ocular lens mounted in the **end opposite the objective lens** of said housing.”

B. 35 U.S.C. §102

In the Office Action of May 4, 2006, claims 45, 46, 50, 51, 53, 73, and 75-80 are rejected as being anticipated by Reed (US Patent #4,695,161), hereinafter “Reed”. (Office Action of May 4, 2006, page 3.)

The Federal Circuit has stated the relevant analysis for anticipation as follows:

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference."²

The Applicants respectfully submit that the reference cited by the Examiner fails to teach each and every element as set forth in the claims.

For example, the Examiner asserts: “Reed discloses a ballistics calculator system for computing targeting information to hit a target, comprising . . . a reticle comprising a plurality of secondary horizontal cross-hairs at predetermined distances along a primary vertical cross-hair and a plurality of secondary vertical cross-hairs at predetermined distances along at least some of the secondary horizontal cross-hairs and an output using the secondary horizontal cross-hairs and secondary vertical cross-hairs to identify an aiming point for hitting the target.” (Office Action of May 4, 2006, page 3).

¹ 65 Fed. Reb. 54603 (Sept. 8, 2000).

² *Verdegaal Bros. V. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

To the contrary, Reed does not recite the reticle of the present invention. Reed recites a reticle that is electrically activated through a group of otherwise invisible lines (Col. 2, lines 15-16). In Reed's reticle only a single vertical cross-hair is visible at all times: "The reticle 14 includes a fixed vertical line 38 which serves as a vertical cross-hair. The line 38 is visible at all times." (Col. 2, lines 30-33). In contrast to the reticle of the present invention, in Reed's reticle only a single horizontal line is displayed at once: "**Each of the lines 40 can be selectively activated while the non-activated lines are essentially invisible.** In FIG. 2 a line 40 α is shown **activated**." (Col. 2, lines 32-37) Figure 2 shows the activated, visible horizontal cross-hair as a solid line, whereas the remaining interrupted horizontal cross-hairs are inactivated, and hence invisible.

In turn, the description of the operation of the Reed reticle makes the distinction between Reed's reticle and that of the present invention clear: "In the present invention, the selected elevation is provided by activating one of the plurality of horizontal cross-hairs within the lines 40 of the reticle 14. **The selected cross-hair is determined by the microprocessor 18.**" (Col. 3, lines 31-35) And: "Based on this information the microprocessor 18 **selects one of the horizontal cross-hairs in lines 40** to provide the desired elevation for the weapon which is aimed by system 10." (Col. 3, lines 52-55) Thus, Reed's reticle with a single "fixed"-visible vertical cross-hair, and a single "activated"-visible horizontal cross-hair does not anticipate the reticle of the present invention in which, for example, a primary vertical cross-hair and a plurality of secondary horizontal cross-hairs are visible.

Similarly, Reed recites "a group of liquid crystal lines 42 which represent vertical cross-hairs. . . . The lines 42, like the lines 40, (i.e., the horizontal cross-hairs) are essentially transparent except when a selected one of the lines, such as 42 α , is activated." (Col. 2, lines 45-52). Thus, FIG. 3 shows only one vertical cross-hair depicted as solid and hence, visible. The remaining vertical cross-hairs in FIG. 3 are depicted as interrupted vertical lines showing that they are invisible, unless one is activated. Hence, Reed's reticle does not anticipate the reticle of the present invention in which a primary vertical cross-hair, a plurality of secondary horizontal cross-hairs, and a plurality of secondary vertical cross-hairs are visible.

Clearly, Reed does not teach the configuration or the operation of the reticle of

the present invention. However, in order to expedite the patent application process in a manner consistent with the U.S. Patent and Trademark Office's Patent Business Goals (PBG)³, and without waiving the right to prosecute the amended or cancelled claims (or similar claims) in the future, in the present Amendment and Response to Office Action of May 4, 2006, claim 45 is amended herein to read: "a plurality of visible secondary horizontal cross-hairs at predetermined distances along a visible primary vertical cross-hair; and a plurality of visible secondary vertical cross-hairs at predetermined distances along at least some of said secondary horizontal cross-hairs;". Claim 46 is amended to read: "a visible primary horizontal cross-hair." Claim 74 is amended to read: "a visible primary vertical cross-hair and a visible primary horizontal cross-hair". And claim 75 is amended to read: "1) a plurality of visible secondary horizontal cross-hairs at a predetermined distance along a visible primary vertical cross-hair; and 2) a plurality of visible secondary vertical cross-hairs".

In view of the above, the Applicants request that this rejection be withdrawn.

C. 35 U.S.C. §103(a)

In the Office Action of May 4, 2006 claims 47, 52 and 54 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reed as applied to claims 45 and 46, and further in view of Wascher *et al.* (US Patent #5,491,546), hereinafter "Wascher". As well, claim 74 is rejected under 35 U.S.C. §103(a) as being unpatentable over Reed applied to claim 45, and further in view of Cohen (US Patent #5,375,073), hereinafter "Cohen". (Office Action of May 4, 2006, page 4.)

A *prima facie* case of obviousness requires the Examiner to cite to a reference which a) discloses all the elements of the claimed invention, b) suggests or motivates one of ordinary skill in the art to combine the claim elements to yield the claimed invention, and c) provides a reasonable expectation of success should the claimed combination be carried out. Failure to establish any one of these three requirements negates a finding of a *prima facie* case and, without more, entitles the Applicants to allowance of the claims in issue. (MPEP)

³ 65 Fed. Reg. 54603 (Sept. 8, 2000).

The Applicants note that the Examiner's combinations of references do not teach all elements of the claims. For example, none of the Examiner's references, alone or in combination, recite a plurality of visible secondary horizontal cross-hairs at predetermined distances along a visible primary vertical cross-hair. As well, none of the Examiner's references, alone or in combination, recite a plurality of visible secondary vertical cross-hairs at predetermined distances along at least some of the secondary horizontal cross-hairs. Moreover, none of the Examiner's references, alone or in combination, recite the combination of a plurality of visible secondary horizontal cross-hairs at predetermined distances along a visible primary vertical cross-hair, with a plurality of visible secondary vertical cross-hairs at predetermined distances along at least some of the secondary horizontal cross-hairs.

In view of the above, the Applicants request that this rejection be withdrawn.

CONCLUSION

All grounds of rejection of the Office Action of May 4, 2006 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that the Applicant's claims as amended should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application the Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

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